



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Ex Parte: SASUTA, MICHAEL
Application Number: 09/014,525
Filing Date: January 28, 1998
Title: Method and Apparatus for Processing
Services in a Communications System

Group: 2666
Examiner: FRANK DUONG

BRIEF ON BEHALF OF APPELLANTS UNDER 37 CFR 41.37

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I. REAL PARTY IN INTEREST

The name of the real party in interest for purposes of this appeal is Motorola, Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals of interferences known to the Applicant, the Applicant's legal representative, or assignee which would directly affect or be directly affected by or having a bearing on the Board's decision in this pending appeal.

III. STATUS OF CLAIMS

Claims 1-12 and 49-55 remain in the application. Claims 1-12 and 49-55 are being appealed. Claims 1-12 and 49-55 stand or fall together. In the final Office Action dated January 16, 2004, the Examiner rejected Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) as being clearly anticipated by Pepe et al (USPN 5,742,668).

IV. STATUS OF AMENDMENTS

A Response after Final Rejection was filed 16 March 2004, subsequent to a final rejection mailed 16 January 2004. No amendments were made to the claims at that time. A Response to the Initial Office Action was filed January 22, 2003. Claims 1-12 were amended to clarify "receiving" and "sending" "service processing logic" that is required for processing services.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A novel method for processing services in a communication system is proposed by Applicants. A demonstration of this method is exemplified by FIG. 2, 7-8 and at text starting at

page 6, line 28. Applicants' Specification, page 6, line 28. In particular, the novel method requires "service processing logic" and "executing ... service processing logic."

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1-12 and 49-55 are patentable under 35 U.S.C. §102(e) over Pepe.

VII. ARGUMENT

Claims 1-12 and 49-55 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Pepe (U.S. Patent No. 5,742,668).

MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim

Regarding Claim 1, the Examiner asserts that "Pepe discloses in a communication system (Fig. 4) that includes a service provider (48) and a subscribers (30), a method for processing services comprises the steps of: indicating to the subscriber that the service provider is capable of supporting a service (col. 16, line 36-50); receiving service processing logic from the subscriber to allow the service provider to provide the service (see col. 18, lines 1-16 and col. 19, lines 66 to col. 20, line 52); executing the service processing logic received from the subscriber based on the service processing logic when the service has been requested (see col. 18, lines 16-20)." Office Action, January 16, 2004, pages 2-3; Office Action, May 8, 2003, pages 2-3. Further, the Examiner asserts that "Pepe ... discloses PCI server 48 (corresponding to "service provider") receive e-mail notification (corresponding to "service processing logic") from PDA 30 (corresponding to "subscriber") (col. 18, lines 1-16)." Office Action, January 16, 2004, page 8. It is noted that the Examiner's reliance upon Pepe appears to be misplaced.

Contrary to the Examiner's statement that all elements are disclosed in the Pepe reference, the term "service processing logic" and the step of "executing ... service processing logic" are not, so the rejection is unsupported by the art and should be withdrawn.

The Examiner defines “service processing logic” while discussing the step of “receiving service processing logic.” The Examiner states that the step of “receiving service processing logic” is disclosed in “col. 18, lines 1-16 and col. 19, line 66 to col. 20, line 52.” Office Action, January 16, 2004, page 3. Col. 18, lines 1-16 disclose a message flow of sending an e-mail from a PDA to a PCI server and disclose that a subsequent message be sent by the PCI server to the PDA to acknowledge receipt of the e-mail. Col. 18, lines 1-16. The Examiner appears to be stating that Pepe’s disclosure of receiving an e-mail at a PCI server is the same as Applicants’ claimed step of “receiving service processing logic.” This is not true. Again, the Examiner appears to be stating that the Pepe’s e-mail notification corresponds to Applicants’ “service processing logic.” See “Pepe … discloses PCI server 48 (corresponding to “service provider”) receive e-mail notification (corresponding to “service processing logic”) from PDA 30 (corresponding to “subscriber”) (col. 18, lines 1-16).” Office Action, January 16, 2004, page 8. Contrary to the Examiner’s assertions, there is no correspondence between Pepe’s e-mail or e-mail notification and the “service processing logic” of Applicants’ claimed invention and will be further explained below.

In interpreting pending claim terms, the Examiner is reminded that MPEP 2111 requires that pending claims be given their broadest reasonable interpretation *consistent* with the specification. The term “service processing logic” as used in the claims is defined in the specification at various places including “e.g. the service processing application and/or user customization software,” “[t]he service processing logic is stored in memory … and may include the entire software application to process a particular service and/or customize custom user parameters, and “[t]he service processing logic includes at least one of a service application and customer user parameters.” Applicants’ Specification page 4, lines 21-22; page 7, lines 19-22; page 14, lines 20-24. Thus, MPEP 2111 requires that the term “service processing logic” be interpreted as defined at various places in the Applicants’ Specification including the pages cited above. For Pepe’s disclosure of e-mail or e-mail notification to correspond to the “service processing logic” of the claimed invention, Pepe’s e-mail or e-mail notification must be defined as an “application” or “software.” As is known to one or ordinary skill in the art and as is acknowledged in the Pepe reference, e-mail or e-mail notification is commonly known as a message and not as an “application” or “software.” See col. 1, lines 17-21; col. 3, lines 48-51; col. 5, lines 49-54. In light of Applicants’ Specification, Pepe’s disclosure of e-mail or e-mail notification is not “service processing logic” as used in the claimed invention.

In the Office Action, January 16, 2004, page 9, the Examiner states that “[a]pplicants are reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” Applicants completely agree with the Examiner that limitations from the specification are not read into the claims; however, Applicants do not ask that the Examiner import limitations into the claims, but ask that the Examiner give the claims an interpretation *consistent* with Applicants’ Specification. Interpreting “service processing logic” as e-mail or e-mail notification is *not* consistent with the specification. Applicants’ Specification requires that “service processing logic” be defined as “e.g. the service processing application and/or user customization software,” “[t]he service processing logic is stored in memory … and may include the entire software application to process a particular service and/or customize custom user parameters, and “[t]he service processing logic includes at least one of a service application and customer user parameters.” Applicants’ Specification page 4, lines 21-22; page 7, lines 19-22; page 14, lines 20-24. From these passages, a complete description of the term “service processing logic” is defined and MPEP 211 requires that the term “service processing logic” be interpreted as defined in these passages and at various other places in the Applicants’ Specification. Thus, it is clear that the term “service processing logic” is missing from the Pepe reference and thus the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

The Examiner states that the step of “executing … service processing logic” is disclosed in “col. 18, lines 16-20” of the Pepe reference. Office Action, January 16, 2004, page 3. Col. 18, lines 16-20 discloses putting an e-mail in original order and forwarding the e-mail to a message transfer agent. For the Examiner to be correct in his assertion that Pepe discloses the elements of the present invention, the PCI server 48 would need to execute service processing logic received from the PDA. That, however, is not the case. The PCI server of Pepe does not “execute” service processing logic and further does not receive service processing logic from the PDA. The PCI server receives e-mail messages from the PDA and not “service processing logic” and further the e-mail messages that the PCI server receives from the PDA can not be executed by the PCI server. Thus, the step of “executing … service processing logic” is missing from the Pepe reference. Since none of the cited passages disclose the step of “executing … service processing logic,” the Examiner’s reliance on Pepe appears to be mistaken.

Contrary to the Examiner’s statement that the Pepe reference discloses the Applicants’ claimed invention, the term “service processing logic” and the step of “executing … service

processing logic" are missing from the Pepe reference. Thus, the rejection of Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

For the reason set forth above, Applicants submit that the Examiner has incorrectly rejected Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) and request that the Board withdraw the rejection.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. In a communication system that comprises a service provider and a subscriber, a method for processing services comprises the steps of:
 - indicating to the subscriber that the service provider is capable of supporting a service;
 - receiving service processing logic from the subscriber to allow the service provider to provide the service; and
 - executing the service processing logic received from the subscriber to provide the service to the subscriber based on the service processing logic when the service has been requested.
2. The method of claim 1 wherein the step of indicating is performed upon receipt of at least one of: a service registration from the subscriber and a service invocation from the subscriber.
3. The method of claim 49 further comprising the steps of:
 - receiving an indication of capabilities of the service provider; and
 - determining whether the service provider is capable of supporting the service based on the indication of capabilities.
4. The method of claim 1 further comprising the steps of:
 - receiving an indication of service requirements for the subscriber; and
 - determining whether the service provider is capable of supporting the service based on the indication of service requirements.
5. The method of claim 1 further comprising the step of storing a service application, and wherein the service processing logic comprises custom user parameters, wherein the custom user parameters modify the service application to meet customization requirements of the subscriber.
6. The method of claim 1 wherein the service processing logic comprises a service application and custom user parameters that relate to the service.

7. The method of claim 6 further comprising the step of queuing the service when at least one of: the service provider has insufficient processing and memory, and the communication system has insufficient communication resources.
8. The method of claim 1 further comprising the step of deleting the service processing logic based on deletion parameters, wherein the deletion parameters comprise at least one of: a time out period, service priority, processing and memory availability, number of times the at least one service has been executed exceeds a threshold, and lack of activity.
9. The method of claim 1 further comprising the steps of:
receiving a command from the subscriber; and
disabling the service processing logic in response to the command when the subscriber is authorized to command disablement of the service processing logic.
10. The method of claim 9 further comprising the step of disabling the service processing logic by at least one of: erasure and inactivation.
11. The method of claim 10 further comprising the step of, when the service processing logic was disabled by inactivation, subsequently receiving a second command from the subscriber to reactivate the service processing logic.
12. The method of claim 1 further comprising the step of receiving authentication from the subscriber to allow the service provider to support the service.

Claims 13-23 (withdrawn)

Claims 24-31 (canceled)

Claims 32-48 (withdrawn)

49. In a communication system that comprises a service provider and a subscriber, a method comprising the steps of:
determining that the service provider is capable of supporting a service;

sending service processing logic to the service provider to allow the service provider to provide the service; and

receiving the service based on the service processing logic from the service provider when the service is requested.

50. The method of claim 49 wherein the service processing logic comprises custom user parameters, wherein the custom user parameters modify a service application stored at the service provider to meet customization requirements of the subscriber.

51. The method of claim 49 wherein the service processing logic comprises at least one of a service application and custom user parameters that relate to the service.

52. The method of claim 49 further comprising the step of sending an indication of service requirements to the service provider.

53. The method of claim 49 further comprising the step of sending a disable command to the service provider to disable the service provider from providing the service based on the service processing logic.

54. The method of claim 49 further comprising the step of authenticating the service provider to allow the service provider to support the service with the service processing logic.

55. The method of claim 1 further comprising the steps of:

receiving a request for the service from a second subscriber; and

executing the service processing logic received from the subscriber to provide the service to the second subscriber.

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, entered by the examiner and relied upon by the appellant in the appeal, or relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court of the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. § 41.37.